

**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 2132**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No: 10/661,350 § Examiner: Almeida, Devin E.
Filed: September 12, 2003 § Group/Art Unit: 2132
Inventor(s): § Atty. Dkt. No: 5646-00900
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Title: SIGNATURE §
 VALIDATION AND §
 GENERATION §

REQUEST FOR PRE-APPEAL BRIEF REVIEW

ATTN: BOX AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below. Applicant is in receipt of the Advisory Action of February 8, 2008. Claims 1, 2-12, and 13-23 are pending in the present case. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments are presented, and that additional arguments, e.g., directed to the subject matter of various ones of the dependent claims, will be presented if and when the case proceeds to Appeal. Claims 1-4, 7, 8, 10, 12, 13, 18, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kinnis (WO 01/13574, "Kinnis").

Regarding claim 1, Kinnis fails to disclose carrying out an integrated validation and storing process, wherein said signature is validated based on a validation algorithm and a key and said received message is stored in a database, and wherein said carrying out the

integrated validation and storing process comprises storing said message and validating said signature within one atomic process. With respect to this feature, the Office Action relies on page 16, lines 11-page 17, line 9 and page 15, lines 8-15. Page 16, lines 11-19 describe validation of the certificate by valid date range and whether or not the certificate has been revoked. Page 16, line 20-page 17, line 9 describe decryption of the signature with a public key. If at any point the certificate is not verified or the decryption process fails, an error is generated and the process is halted. Page 15, lines 8-15 teaches that the digital signature service may verify the integrity of a document and, if it is verified, the document may be stored in a persistent store. Thus, Kinnis teaches verification and decryption as well as storage (upon successful verification) in a data store. Applicant notes that the process taught by Kinnis is substantially described in the background section of Applicant's own disclosure (see page 2) where prior art signatures may be used a key to generate a signature, validate the signature, and then store the signature. However, as noted on page 2 of Applicant's disclosure, this method has drawbacks, including the possibility of modification of the message content between validation of the signature and further processing by the receiver.

Accordingly, Applicant is claiming an improvement over the teaching of Kinnis whereby the validation and storing of the digital signature is performed as an integrated process. Applicant respectfully submits that Kinnis nowhere indicates that the validation and storage is an integrated process, where no modification can occur between validation and storage. Instead, Kinnis describes each of these steps separately and does not teach or suggest that the signature is validated based on a validation process and key and then stored in a database in an integrated process.

In response to these arguments, the Office Action first states, “It is noted that the features upon which applicant relies (i.e., where no modification can occur between validation and storage) are not recited in the rejected claim(s).” Applicant respectfully submits that the present claim recites that the validation and storage is an integrated process and occurs within one atomic process. It is clear from Applicant’s specification that this feature has the advantage of protection from modification over Kinnis. Furthermore, as one skilled in the art understands, the use of the term “atomic process” in the claim clearly expresses how a possible modification of a message between validation and storage is prevented. Applicant submits that the Office Action has simply ignored the actual presented argument—that the process is integrated and occurs within one atomic process, which, as already submitted, is nowhere indicated in Kinnis.

The Office Action goes on to assert:

Kinnis teaches wherein in said integrated validation and storing process said message is stored and said signature is validated within one atomic process on page 15 lines 8-15 i.e. if the document is verified through the digital signature, the document and the signature are stored in a persistent data such as data store. [Sic]

Applicant has carefully reviewed the cited portion as well as the entirety of Kinnis and respectfully submits that there is **absolutely no** indication that the storage and validation of Kinnis is an integrated process which occurs within one atomic process. Instead, as already indicated, the cited portion teaches that the digital service may verify the integrity of a document, and then, if verified, store the document. Simply teaching the individual steps of storage and corresponding validation amounts to nothing more than what is already identified in Applicant's own Background. In other words, there is no indication that Kinnis teaches anything other than the problem that the present Application addresses. As specifically required in the claims, the storage and validation steps must be integrated and occur within one atomic process. As already submitted, there is no teaching or suggestion of this feature in Kinnis, and furthermore, there is no occurrence of the terms "integrated" or "atomic process", much less any description ascribing these terms to validation and storage steps as required by claim 1.

Furthermore, Applicant notes that page 17, lines 6-7 states that after the previously described verification process is completed, the "recipient may process the document in any manner". There is no indication in this section of the necessity to store the document. Further, on page 3, lines 24-25, Kinnis states that the user may "store and/or transmit the document using any program for storing and transmitting files". Thus, in this case, Kinnis appears to **teach away** from the integrated process recited in the claims by stating that the document may be transmitted as an alternative to storing; clearly, if the document is not stored, but is transmitted, the validation storage process cannot be said to be "integrated" or occurring "within one atomic process". Additionally, Figure 8 illustrates a validation step, but makes no mention of storage in an integrated step or within an atomic process. Applicant respectfully submits that were the two steps actually integrated, Kinnis would have indicated this at some point. The Examiner cannot simply assume that this feature is taught absent some teaching or suggestion otherwise from the prior art in any rejection, much less a **section 102 rejection**.

Finally, the present Advisory Action responds:

Applicant's arguments with respect to claim 2 and 13 have been fully considered, but they are not persuasive. Kinnis teaches wherein in said integrated validation and storing process said message is stored and said signature is validated within one atomic process on page 15 lines 8-15 i.e. if the document is verified through

the digital signature, the document and the signature are stored in a persistent data store as data store. The document is stored every time the document is verified.

Applicant respectfully submits that this assertion fails to address the substance of the arguments previously presented by Applicant. Applicant is not arguing that Kinnis fails to teach document verification and storage, but instead that Kinnis nowhere indicates that this procedure is integrated and performed within one atomic process as required by claim 1. This is nowhere described in Kinnis. Thus, Applicant respectfully submits that the present Office Action has failed to address the actual arguments presented by Applicant or provide a *prima facie* rejection of claim 1.

Regarding claim 3, Kinnis fails to disclose **wherein the storing process is rolled back, if the signature is not valid**. The Office Action relies on the storage of verified messages in a data store (page 15, lines 8-15) for this feature. However, Applicant respectfully submits that this section is completely irrelevant with respect to this feature of claim 3. Applicant notes that Kinnis teaches that an error is generated when the key is not valid or verified, but does not indicate that the storage process is rolled back. Correspondingly, Kinnis fails to disclose this feature of claim 3.

In response to these arguments, the Office Action asserts:

Kinnis teaches wherein in said integrated validation and storing process said message is stored and said signature is validated within one atomic process on page 15 lines 8-15 i.e. if the document is not verified through the digital signature, the document and the signature are not stored in a persistent data store such as data store. [Sic]

Applicant first notes that the cited language occurs in previous claim 2 and is not recited in claim 3. Instead, claim 3 actually recites **wherein the storing process is rolled back, if the signature is not valid**. Applicant further notes that the provided sentence is actually not provided from Kinnis; instead, Kinnis states that if the document is verified, the document and the signature are stored in the persistent data store. This citation does not necessarily indicate the inverse statement as asserted by the Office Action, as one who is familiar with logic understands. Finally, Kinnis does not disclose what occurs if the signature is not valid.

Regarding claim 12, Kinnis fails to disclose **carrying out an integrated receiving and generating process, wherein said message to be sent is received and said signature is generated based on a signing algorithm and a key, and wherein said carrying out the**

integrated receiving and generating process comprises receiving said message to be sent and generating said signature within one atomic process. With respect to this feature, the Office Action relies on page 12, line 12 – page 15, line 5 of Kinnis. This section describes that a document and key may be retrieved from a data store, and that the signature may be generated. Similar to arguments above regarding claim 1, there is no indication that this is an integrated receiving and generating process which occurs within one atomic process. **Applicant notes the Office Action does not address these arguments.**

In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested. If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5646-00900/JCH. Also enclosed herewith is the following item:

Notice of Appeal

Respectfully submitted,

/Jeffrey C. Hood/

Jeffrey C. Hood, Reg. #35198

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